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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,099	11/17/2003	Pascal Pegaz-Paquet	66629-019	9786

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MCDERMOTT, WILL & EMERY  
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Washington, DC 20005-3096

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,099

Applicant(s)

PEGAZ-PAQUET ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 8-17 and 23-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/9/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-7 and 18-22 made over the telephone call made on August 19, 2004 with Attorney Burton (Reg. 45,323) and Attorney Bernard Codd (Reg. 46,429) is noted. Accordingly, claims 8-17 and 23-106 have been withdrawn from further consideration. For the benefit of the applicant a summary copy of this restriction requirement (originally mailed to Att. Burton on August 19, 2004) is presented herewith.

Restriction to one of the following inventions is required without traverse:

This election/restriction requirement is based upon the claims being drawn to distinct inventions as multiple embodiments of the system, method and product. Please note that each group includes distinct features, which are not required for other groups.

Group I: claims 1-6 and 7 and 18-22 (user qualification and a gateway device having IVR)

Group II: claims 7, 8, 23-26 and 30 (remote terminal includes a call source identification device)

Group III claims 7, 9-10, 27-29, 31-39 (call detail recording device and billing device)

Group IV claims 7, 11, 13-17 (user terminal includes a web browser)

Group V (5) claims 7 and 12 (user terminal includes a mobile telephone with wireless communication link)

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Group VI claims 40-42 and 48-62 (mobile commerce network and mobile communication device)

Group VII claims 40 and 43-44 (having a gateway device connected to the mobile commerce network)

Group VIII claims 40 and 45-47 (negative status retrieval device and disconnect device associated therewith)

Group IX method claims 63 and system claim 7 and 8  
Product claim 85

Group X (**10**) method claims 63 and 65-67 (download of automatic dialer software)  
Product claims 85-90

Group XI method claims 63 and 68 (verify user qualification) and product claim 85, 91

Group XII method claims 63 and 69 (gateway device)

Group XIII method claims 63 and 70-72 (disconnecting the connection based upon negative information) and product claims 85, 92-94

Group IXV method claims 63 and 73-77 (e-commerce network usage) and product claims 85, 95-99

Group XV (**15**) method claims 63 and 78 (revalidating..) and product claims 85, 100

Group XVI method claims 63 and 79 (creating a new call detail) and product claims 85, 101

Group XVII method claims 63 and 80 (generating letters) and product claims 85, 102

Group XVIII method claims 63 and 81 (tracking and recording collection activity) and product claims 85, 103

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Group IXX method claims 63 and 82 (generating and compiling reports) and product claims 85, 104

Group XX (20) method claims 63 and 83 (displaying notes history) and product claims 85, 105

Group XXI method claims 63 and 84 (invoicing user according to taxes) and product claims 85, 106

Election to one invention without traverse is required in order to grant the petition to make special.

As noted above, an election of Group I claims 1-7 and 18-22 was made without traverse.

***Claim Rejections - 35 USC § 112 (Second)***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 and 7 and 18-22 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independents Claim 1 and 7 recite in the preamble that the system is intended for managing accounting and billing of transactions over an e-commerce network. Claim 1, in the preamble further recites the elements and functionality of the

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elements of the e-commerce network by language "an e-commerce network comprising..".

It is interpreted that the system claim of this nature recites its intended use as "managing accounting and billing of transactions over an e-commerce network" because only element of the system is recited as "a gateway device" and not the e-commerce network including it's constituent parts which are recited in the preamble only in the form of intended use.

In this regard the examiner points out that:

..the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In the present case there is no structure supporting the intended use because the claim does not recite the e-commerce network and the elements it is comprised of as positive elements of the system. The system only comprises a gateway device and the claim is analyzed accordingly.

Likewise, claim 1 recites the only limitation of the system as "a gateway device configured to provide access to the e-commerce network subsequent to verification of each required user qualification".

There is no further structure recited in regard to the verification process. Note that the claim recites the manner in

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which the verification is performed. However, the gateway device does not depend upon the specific manner in which the verification is carried out to perform it's function, i.e. to provide access to the network subsequent to verification of the user qualification.

The examiner has broadly interpreted the system claim as reciting a gateway device configured to provide access to a e-commerce network subsequent to verification of each user qualification.

4. Claims 1-7 and 18-22 recite in preamble, "a system for managing accounting and billing of transactions" as objective of the claimed invention. However, no limitation(s) is recited which concerns or accomplish this objective and subject matter. This deficiency renders the claims indefinite.

5. Claim 5 recites the limitation "the established connection" in line 2. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 7 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting

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to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships of remote terminal and qualification request is lacking as well as structural cooperative relationships of these elements to the e-commerce network.

7. claim 7 refers to "a unique identifier" as related to the remote terminal and the qualification verification device. This renders the claim unclear.

8. In view of the foregoing deficiencies the claims have been interpreted as best understood by the examiner and have been examined accordingly.

***Claim Rejections - 35 USC § 112 (Second)***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph as having undue breadth because the claims contain means recitation that does not appear in combination with another recited element of means (refer to MPEP 2164.08(a)).



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The reference claims only recite a single means (a gateway device) which is not recited in combination with any other means that further define the means for managing accounting and billing transactions.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feather (US 2004/0081173A1, filed Oct.15, 2002).

12. Per claims 1-4, Feather teaches a gateway device (refer to operator network 18 which comprises serving node 26 and border gateway 20) which is configured to provide access to the Internet 24 subsequent to verification of each required user qualification (see at least para [0016], the serving node 26 provides user qualification, user identifier, password and other data received from mobile device 12, after processing this

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information the serving node forwards the network access request to the appropriate gateway).

13. Feather does not expressly show a qualification verification device which performs the verification of each required user qualification as per claim 1.

14. Feather, further does not expressly show that the verification of at least one required user verification is based on a user credit rating.

15. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the operation of the gateway device. The gateway device would provide access to the network subsequent to verification of each user qualification regardless the nature of the verification process.

16. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

17. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the gateway device configured in the manner recited in claim 1 because such data does not functionally relate to the

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steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

18. Claims 2-4 further limit the user qualification input which is not positively recited as an element of the system. Instead, as explained in claim 1 analysis, it is a part of "non-functional descriptive material" that does not effect functionality of the gateway device.

19. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feather (US 2004/0081173A1, filed Oct.15, 2002)as applied to claim 1 and further in view of Hill et al. (US 2004/0226459) (Hill).

20. Feather fails to teach, however, Hill teaches a gateway device which includes an interactive voice response server configured to interact with the user and wherein the server is further configured to request user input of user identifier and to recognize the user unique identifier (see Figure 4 and 5, and para [0053] through [0061]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the IVR response server to the Feather Gateway

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system. Motivation for this combination is enable the user to interact the e-commerce network using voice data and voice communication device such as landline and wireless phones.

21. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skantze (US 2003/0014327 A1, filed Sept. 24, 2002, priority date July, 6, 2001).

Per claim 7 Skantze teaches a system which comprises a remote terminal configured to receive a request to access an e-commerce network, the remote terminal having a unique user identifier retrieval device configured to retrieve a unique user identifier from at least one database (server unit CH, see Fig. 1 and 2, in association with database 20, see para [0060])

22. and a qualification verification device configured to verify at least one required user qualification in response to user qualification input (Registration server RS, see Fig. 1 and 2).

23. Skantze does not expressly show that the verification of at least one required user verification is based on a user credit rating.

24. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the operation of the qualification verification

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device. The qualification verification device would provide verification of each user qualification regardless the nature of the verification process.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the qualification verification device of Skantze configured in the manner recited in claim 7 because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

25. Claims 18-20 further limit the user qualification input which is not positively recited as an element of the system. Instead, as explained in claim 1 analysis, it is a part of "non-functional descriptive material" that does not effect functionality of the gateway device.

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26. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skantze (US 2003/0014327 A1, filed Sept. 24, 2002, priority date July, 6, 2001) as applied to claim 1 and further in view of Hill et al. (US 2004/0226459) (Hill).

27. Regarding claim 21-22, Skantze fails to teach, however, Hill teaches a gateway device which includes an interactive voice response server configured to interact with the user and wherein the server is further configured to request user input of user identifier and to recognize the user unique identifier (see Figure 4 and 5, and para [0053] through [0061]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the IVR response server to the Feather Gateway system. Motivation for this combination is enable the user to interact the e-commerce network using voice data and voice communication device such as landline and wireless phones.

#### **Conclusion**

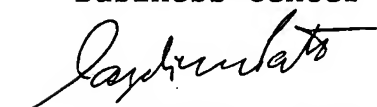
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

8/3/05